

REMARKS

By this amendment, claims 1, 3, and 10-12 are amended; claims 9 and 16-19 are cancelled; and claims 1-8 and 10-15 are pending. Claims 1 – 4, 8 – 9, and 11 – 13 were rejected as anticipated by *Gofman et al.* '520; claims 5 -- 7 and 10 were indicated as allowable, but objected to as depending from a rejected base claim; and, claim 15 was allowed. Claim 14 was not indicated as being rejected or objected to, and is therefore presumably allowable. If this is incorrect, applicant would respectfully request another office action setting forth any reasons for rejection of and/or objection to claim 14 (see MPEP 707.07(i)). Further examination of the application as amended and reconsideration of the rejections and objections are respectfully requested.

The courtesy of the telephonic interview extended by Examiner Manahan to undersigned counsel for applicant on or about July 28, 2005 is gratefully acknowledged. It is believed that agreement was reached regarding the allowability of the claims upon presentation of claim amendments along the lines presented herein. Arguments advanced during the interview are presented herein.

Claim 1 has been amended to include an element of an inductor within the handpiece, thus distinguishing that the passive circuit element is not the inductor in the handpiece; support for this amendment can be found inter alia in the specification at paragraphs [0040] to [0048] and Figs. 4B and 4C. Claim 3 has been amended to affirmatively recite the second potentiometer. Claim 10 has been rewritten as an independent claim including the limitations of claim 9, which has been cancelled, and claim 11 is amended to depend from claim 10. Claim 12 is similarly amended to affirmatively recite the circuitry in the dental scaler and the first potentiometer as distinct elements. Support for the "signal generation circuitry," "separate" [potentiometer], and "operatively" [connects] terminology, is found in the specification at [0054] and [0060], among others. No new matter is

Appl. No. 10/065,274
Response dated 2005-07-28

introduced by these amendments. Further, the amendments should be admitted after final rejection since they place the case in condition for allowance and/or better form for appeal.

The amendment to claim 1 makes it clear that the recited "passive circuit element" is separate and distinct from the induction coil in the handpiece. Applicant did not intend for the passive circuit element to be met by the handpiece induction coil, but in addition thereto. Applicant's circuits and those disclosed in *Gofman* each contain capacitors, induction coils, etc. However, the passive circuit element in applicant's invention is operational only when coupled to the circuitry via the handpiece connector, as disclosed in paragraphs [0042] to [0044] and illustrated in Figs. 4B and 4C. *Gofman* does not provide for a passive circuit element which is operational only when coupled to the circuitry via the handpiece connector. Therefore, *Gofman* does not anticipate the passive element required in the handpiece connector of claim 1.

Furthermore, the amendment to claim 3 renders it similar in scope to claim 10, which has been indicated as being allowable. By affirmatively reciting the second potentiometer, it is clear that the second potentiometer is integral to the apparatus and not a mere intended use. Similarly in claim 12, it is clear that the affirmatively recited potentiometer is a separate element and not integrated into the affirmatively recited circuitry until it is made operative by means of coupling via the footswitch connector. *Gofman* does not anticipate these arrangements, nor is there any other prior art of record that teaches or suggests the invention in this regard.

For the reasons set forth above, it is respectfully submitted that *Gofman*, alone or in combination with any other reference of record, does not anticipate, teach, suggest or render obvious the claimed invention of the present application,

Appl. No. 10/065,274
Response dated 2005-07-28

as amended. Entry of the amendment and allowance of all pending claim is respectfully requested.

During the course of these remarks, Applicant has at times referred to particular limitations of the claims which are not shown in the applied prior art. This short-hand approach to discussing the claims should not be construed to mean that the other claimed limitations are not part of the claimed invention. Consequently, when interpreting the claims, each of the claims should be construed as a whole, and patentability determined in light of this required claim construction. Unless Applicant has specifically stated that an amendment was made to distinguish the prior art, it was the intent of the amendment to further clarify and better define the claimed invention.

If the office has any questions or comments regarding this communication, please contact the undersigned directly to expedite the resolution of this application.

Respectfully submitted,



Daniel N. Lundeen
Patent Reg. No. 31,177
Lundeen & Dickinson LLP
PO Box 131144
Houston, Texas 77219
(713) 652-2555 Telephone
(713) 652-2556 Facsimile